



CASE 4-30652A/C1/30889

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1614

ALLGEIER ET AL.

Examiner: C. Delacroix-Munroe

APPLICATION NO: 09/821,416

FILED: MARCH 29, 2001

FOR: MGLUR5 ANTAGONISTS FOR THE TREATMENT OF PAIN AND ANXIETY

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

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REQUEST FOR RECONSIDERATION

Sir:

This is in response to the Official Action dated February 4, 2003.

Claims 31-34 were presented for examination, and Claims 31-34 are still the only claims present in the case.

The withdrawal of Claim 33 from consideration has been noted. However, since the "elected" species, viz., the first compound of Claim 34, is embraced by the scope of Claim 33, i.e., the "elected" species is a compound of formula I wherein "R<sub>1</sub>" is methyl, each of "R<sub>2</sub>", "R<sub>3</sub>" and "R<sub>4</sub>" is hydrogen and "R<sub>5</sub>" is a pyridine-3-yl group, the withdrawal of Claim 33 is improper and does not comply with M.P.E.P. 809.02(c) which states: "[a]n examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species." Accordingly, the Examiner is respectfully requested to reconsider the withdrawal of Claim 33 from consideration and include it among the examined claims.

Applicants have noted the Examiner's comment concerning the fact that they are only entitled to the filing date of the corresponding PCT application, viz., September 30, 1999, since the British priority application fails to support the instantly claimed "anti-anxiety" use. However, it is respectfully pointed out that Applicants are entitled to the filing date of U.S. Application

No. 09/220,813, viz., December 23, 1998, under 35 U.S.C. §120 since it clearly discloses the "anti-anxiety" use.

Applicants acknowledge the Examiner's suggestion regarding the "preferred" arrangement of the specification. In this connection, however, it is respectfully submitted that there is nothing in the Rules or the Statutes which mandates that the specification must be arranged in a specific manner. Accordingly, no changes in the specification are believed to be required.

The Examiner has rejected Claims 31, 32 and 34 under 35 U.S.C. §103(a) as being unpatentable over Allgeier et al. (WO 99/02497). In this connection, from the tenor of the Examiner's comments, it appears that this rejection revolves around the "elected" compound and structurally related compounds. In any event, it is the Examiner's contention that since the Allgeier et al. reference: 1) discloses that mGluR5 antagonists are useful in treating anxiety; 2) specifically discloses the corresponding "ethynyl" bridged compound of the "elected" compound; and 3) teaches the equivalency of "lower alkenylene" and "lower alkynylene" as significances of the "X" bridging group, it would be obvious to one skilled in the art that the "elected" compound would be useful in treating anxiety.

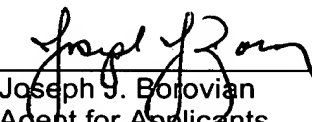
The Examiner's contentions notwithstanding, it is respectfully submitted that Allgeier et al. is not an effective reference against any of the instant claims since its publication date is subsequent to the filing date of U.S. Application No. 09/220,813, the benefit of which Applicants are entitled under 35 U.S.C. §120 (see, in this connection, the above discussion).

In view of the foregoing, the Examiner is respectfully requested to reconsider the 35 U.S.C. §103(a) rejection of Claims 31, 23 and 34 and withdraw it.

The "sole" rejection of record having been overcome, the instant application is believed to be in condition for allowance; and an early notice to that effect is earnestly solicited.

Respectfully submitted,

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